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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,589	09/04/2001	Takayuki Norimatsu	Q66012	1652

7590 11/05/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

JOYCE, WILLIAM C

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/944,589

Applicant(s)

NORIMATSU, TAKAYUKI

Examiner

William C. Joyce

Art Unit

3682

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

William C. Joyce 11/4/03
WILLIAM C. JOYCE
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): The claim rejection based on 35 USC 103 has been withdrawn based on the remarks found on pages 8-9 of the amendment.

Continuation of 5. does NOT place the application in condition for allowance because: the claims stand rejected based on 35 USC 112 first paragraph, because it is not entirely clear applicant had possession of the claimed device at the time the application was filed. The instant disclosure defines an encoder formed as an elastic member made of a base material mixed with a powder of magnetic material, wherein the claimed single pitch deviation and the claimed magnetic flux density of the encoder is obtained by selecting a material for the base rubber material, a material for the powder of the magnetic material, and the mixing ratio thereof. It is not entirely clear applicant had possession of the claimed device because the disclosure fails to clearly identify a specific example of materials and mixing ratios thereof in forming the encoder so as to obtain the claimed single pitch deviation and magnetic flux density. Accordingly, one in the art could not produce the claimed device without undue experimentation.

Examiner notes that the encoder can be made of a heat resistant nitrile rubber, acrylic rubber, or fluorine containing rubber, mixed with a powder of ferrite (see first full paragraph of page 11 of the disclosure), however applicant must provide a specific example of materials and mixing ratios thereof such that one in the art could produce the claimed device without undue experimentation. The mere suggestion that an encoder can be formed with the claimed properties by mixing a number of recited materials is not sufficient because, for example, each combination of materials used in making the encoder may have a specific mixing ratio which may be difficult to reproduce by one in the art. Since applicant has not clearly disclosed the mixing ratio and materials needed in obtaining the claimed encoder, it would be difficult for one in the art to make the claimed encoder member without undue experimentation.